

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION

ADAPTIX, Inc.,

Plaintiff,

v.

DELL, INC., *et al.*,

Defendants.

Case No. 5:14-cv-01259-PSG

v.

AMAZON.COM, INC., *et al.*,

Defendants.

Case No. 5:14-cv-01379- PSG

v.

BLACKBERRY LTD., *et al.*,

Defendants.

Case No. 5:14-cv-01380- PSG

v.

SONY MOBILE COMMUNICATIONS,  
INC., *et al.*,

Defendants.

Case No. 5:14-cv-01385- PSG

v.

BLACKBERRY LTD., *et al.*,

Defendants.

Case No. 5:14-cv-01386- PSG

v.

BLACKBERRY LTD., *et al.*,

Defendants.

Case No. 5:14-cv-01387- PSG

~~[PROPOSED]~~ ORDER REGARDING E-DISCOVERY IN PATENT CASES

The Court ORDERS as follows:

1. This order supplements all other discovery rules and orders. It streamlines Electronically Stored Information (“ESI”) production to promote a “just, speedy, and inexpensive determination” of this action, as required by Federal Rule of Civil Procedure 1.

1 2. This order may be modified in the court's discretion or by agreement of the parties. If the  
2 parties cannot resolve their disagreements regarding any such modifications, the parties shall  
3 submit their competing proposals and a summary of their dispute.

4 3. A party's meaningful compliance with this order and efforts to promote efficiency and  
5 reduce costs will be considered in cost-shifting determinations.

6 4. Absent a showing of good cause, general ESI production requests under Federal Rules of  
7 Civil Procedure 34 and 45, or compliance with a mandatory disclosure requirement of this Court,  
8 shall not include metadata. However, fields showing the date and time that the document was  
9 sent and received, as well as the complete distribution list, shall generally be included in the  
10 production if such fields exist.

11 5. Absent agreement of the parties or further order of this court, the following parameters shall  
12 apply to ESI production:

13       A. **General Document Image Format.** Each electronic document shall be produced in  
14 Portable Document Format ("PDF") or single-page Tagged Image File Format ("TIFF")  
15 format. Each hard copy document shall be scanned and produced in PDF or single-page  
16 TIFF format. TIFF files shall be single page and shall be named with a unique  
17 production number followed by the appropriate file extension. PDF files shall be named  
18 with a unique production number followed by the appropriate file extension.  
19 Concordance load files with opticon shall be provided to indicate the location and  
20 unitization of the PDF or TIFF files. If a document is more than one page, the unitization  
21 of the document and any attachments and/or affixed notes shall be maintained as they  
22 existed in the original document.

23       B. **Text-Searchable Documents.** No party has an obligation to make its production  
24 text-searchable; however, if a party's documents already exist in text-searchable format  
25 independent of this litigation, or are converted to text-searchable format for use in this  
26 litigation, including for use by the producing party's counsel, then such documents shall  
27 be produced in the same text-searchable format at no cost to the receiving party. A party  
28 may produce extracted-text text files to correspond with Concordance load files and the  
produced PDF or TIFF files in lieu of producing text-searchable documents.

1 C. **Footer.** Each document image shall contain a footer with a sequentially ascending  
2 production number.

3 D. **Native Files.** A party that receives a document produced in a format specified above  
4 may make a reasonable request to receive the document in its native format, and upon  
5 receipt of such a request, the producing party shall produce the document in its native  
6 format. A Party may produce a document only in its native format, to the extent such  
7 production of the native format document will not hamper the other Party's review and is  
8 in compliance with the other requirements in this Order.

9 E. **No Backup Restoration Required.** Absent a showing of good cause, no party need  
10 restore any form of media upon which backup data is maintained in a party's normal or  
11 allowed processes, including but not limited to backup tapes, disks, SAN, and other  
12 forms of media, to comply with its discovery obligations in the present case.

13 F. **Voicemail, Instant Messages, and Mobile Devices.** Absent a showing of good  
14 cause, voicemails, instant messages, PDAs and mobile phones are deemed not reasonably  
15 accessible and need not be collected and preserved.

16 G. **Limited Number of ESI Custodians.** Each Party shall identify ESI custodians most  
17 likely to have discoverable information in their possession, custody, or control in view of  
18 the pleaded claims and defenses, infringement contentions and accompanying documents  
19 pursuant to P.R. 3-1 and 3-2, invalidity contentions and accompanying documents  
20 pursuant to P.R. 3-3 and 3-4, and preliminary information relevant to damages. Each  
21 party<sup>1</sup> shall specifically identify seven (7) ESI custodians. These lists are subject to  
22 revision or supplementation. The parties may jointly agree to modify this limit without  
23 the court's leave. The court shall consider contested requests for additional or fewer  
24 custodians per producing party, upon showing a distinct need based on the size,  
25 complexity, and issues of this specific case. The specific identification of ESI custodians  
26 shall include the name and title of the custodian, the custodian's role in the instant dispute,  
27 the subject matter of the information likely to be in the custodian's possession, and a  
28 short description of why the custodian is believed to be significant. An "ESI custodian,"

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<sup>1</sup> For purposes of this Order, any defendants in the above-captioned actions who are related corporate entities (e.g., parent and subsidiary) count as one party.

1 as used herein, does not include common repositories where ESI is stored, such as,  
2 without limitation, technical document repositories, license agreement repositories,  
3 source code repositories, network drives that are shared by numerous individuals,  
4 financial databases, etc. This Stipulation has no effect on the Parties' document  
5 production obligations, if any, regarding such common repositories. For the avoidance of  
6 doubt, and without limiting the generality of the foregoing, a Party need not choose as an  
7 "ESI custodian" a repository where relevant and discoverable materials are stored in  
8 order for those materials to be discoverable.

9 6. General ESI production requests under Federal Rules of Civil Procedure 34 and 45, or  
10 compliance with a mandatory disclosure order of this court, shall not include e-mail or other  
11 forms of electronic correspondence (collectively "e-mail"). To obtain e-mail parties must  
12 propound specific e-mail production requests.

13 7. E-mail production requests shall be phased to occur timely after the parties have exchanged  
14 initial disclosures, a specific listing of likely e-mail custodians, a specific identification of the  
15 most significant listed e-mail custodians in view of the pleaded claims and defenses,<sup>2</sup>  
16 infringement contentions and accompanying documents pursuant to P.R. 3-1 and 3-2, invalidity  
17 contentions and accompanying documents pursuant to P.R. 3-3 and 3-4, and preliminary  
18 information relevant to damages. The exchange of this information shall occur at the time  
19 required under the Federal Rules of Civil Procedure, Local Rules, or by order of the court.  
20 Subject to the limits provided in the Court's Discovery Order, each requesting party may also  
21 propound up to five written discovery requests and take one deposition per producing party to  
22 identify the proper custodians, proper search terms, and proper time frame for e-mail production  
23 requests. The court may allow additional discovery upon a showing of good cause.

24 8. E-mail production requests shall identify the custodian, search terms, and time frame. The  
25 parties shall cooperate to identify the proper custodians, proper search terms, and proper time  
26 frame. Each requesting party shall limit its e-mail production requests to a total of five  
27 custodians per producing party. The parties may jointly agree to modify this limit without the  
28 court's leave. The court shall consider contested requests for additional or fewer custodians per

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<sup>2</sup> A "specific identification" requires a short description of why the custodian is believed to be significant.

1 producing party, upon showing a distinct need based on the size, complexity, and issues of this  
2 specific case.

3 9. Each requesting party shall limit its e-mail production requests to a total of seven search  
4 terms per custodian per party. The parties may jointly agree to modify this limit without the  
5 court's leave. The court shall consider contested requests for additional or fewer search terms per  
6 custodian, upon showing a distinct need based on the size, complexity, and issues of this specific  
7 case. The search terms shall be narrowly tailored to particular issues. Indiscriminate terms, such  
8 as the producing company's name or its product name, are inappropriate unless combined with  
9 narrowing search criteria that sufficiently reduce the risk of overproduction. A conjunctive  
10 combination of multiple words or phrases (e.g., "computer" and "system") narrows the search  
11 and shall count as a single search term. A disjunctive combination of multiple words or phrases  
12 (e.g., "computer" or "system") broadens the search, and thus each word or phrase shall count as a  
13 separate search term unless they are variants of the same word. Use of narrowing search criteria  
14 (e.g., "and," "but not," "w/x") is encouraged to limit the production and shall be considered  
when determining whether to shift costs for disproportionate discovery.

15 10. Pursuant to Federal Rule of Evidence 502(d), the inadvertent production of a privileged or  
16 work product protected ESI is not a waiver in the pending case or in any other federal or state  
17 proceeding.

18 11. The mere production of ESI in a litigation as part of a mass production shall not itself  
19 constitute a waiver for any purpose.

20 12. Except as expressly stated, nothing in this order affects the parties' discovery obligations  
21 under the Federal or Local Rules, or this Court's Discovery Order.

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24  
25 Date: January 22, 2015

  
Paul S. Grewal

U.S. Magistrate Judge